

### C. REMARKS

#### I. CLAIM AMENDMENT

Claim 1 was amended to indicate a light fixture designed to be mounted to a wall, a post, or a chain. Support for the amendment can be found among other places in the drawings and in paragraph 0002 of the specification.

#### II. EXAMINER'S REJECTIONS - 35 U.S.C. 103(a)

##### A. Claims 1, 2 and 7

The Examiner has rejected claims 1-2 and 7 as being obvious over U.S. Patent No. 6,296,377 Wilson et al ("Wilson") in view of U.S. Patent No. 6,913,376 to Judd et al. ("Judd"). To establish a *prima facie* case of obviousness, the Examiner must show the following:

- (1) the prior art reference (or references when combined) must teach or suggest all the claim limitations;
- (2) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; and
- (3) there must be a reasonable expectation of success.

MPEP 2143.

The Examiner has acknowledged that the above elements must be shown in order to establish a *prima facie* case of obviousness in the September 7, 2005 Office Action.

The Examiner has failed to show a *prima facie* case of obviousness in this case because the Examiner has not shown suggestion or motivation to modify or combine the reference teachings and has not shown an expectation for success.

“[A]n examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention.” *In re Rouffett*, 149 F.3d 1350, 1357 (Fed Cir. 1998).

The Examiner states, “ It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the convertible modular lantern of Wilson with the locking mechanism for nonthreadably releaseably coupling the light fixture body of Judd et [sic] l., since the nonthreadably releaseably coupling the light fixture body of Judd would provide Wilson with the hole at the center of the boot and the turning of the light source to engage the light source’s quarter turn locking mechanism.”

“A statement that modifications of the prior art to meet the claimed invention would have been 'well within the ordinary skill of the art' at the time the claimed invention was made'

because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references”. MPEP 2143 (citing *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993)).

As can be seen from section 2143 of the MPEP, the Examiner is improperly making a judgment of obviousness solely on the basis that the references show all elements.

The only motivation to combine or modify the references are the Applicants' claims. The Examiner has used the Applicants' claimed invention as a blueprint and has combined references without any teaching or motivation to do so. It is well established law that it is improper to use Applicants' claims as a blueprint and to reconstruct the invention from the prior art using the claim as a blueprint. *Grain Processing Corp. v. American Maize Products Corp.*, 840 F.2d 902 (Fed. Cir. 1988); *Smith Kline Diagnostics Inc. v. Helena Laboratories Corp.*, 859 F.2d 878 (Fed. Cir. 1988); *In re Stencel*, 828 F.2d 751 (Fed. Cir. 1987); *In re Dow Chemical*, 837 F.2d 469 (Fed. Cir. 1988); *Northern Telecom, Inc. v. Datapointe Corp.*, 908 F.2d 931 (Fed. Cir. 1990), *cert. denied*, 11 S.Ct. 296 (1990); *Interconnect Planning Corp., v. Feil*, 774 F.2d 1132 (Fed. Cir. 1985).

The Declaration of Expert Fred W. Kimick dated December 5, 2005 shows that there is no teaching or suggestion to modify the references.

The Examiner also argues, “In this case, the references cited are analogous for being in

the same field of invention like Applicant's claimed invention, because it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention."

The Examiner is correct to indicate that the art must be analogous in order to be used as a basis for an obviousness rejection.

However, Applicants disagree with Examiner that the references cited by the Examiner are in the same field of invention. Applicants' field of invention is a home lighting fixture. Additionally, the Declaration of Expert Fred W. Kimick dated December 5, 2005 establishes that home light fixtures and automotive light assemblies are in different fields. The Expert's Declaration indicates the following:

- (i) Applicant's invention is a light fixture for a house or a home;
- (ii) Automotive light assemblies are often referred to as Headlamps;
- (iii) Home light fixtures cannot be used as an automotive light assembly;
- (iv) An automotive light assembly cannot be used as a home light fixture;
- (v) I know of no instances in which a person of ordinary skill in the home light fixture industry considered automotive light assemblies to make a home light fixture; and
- (vi) The two are totally different fields.

B. Claim 4

The Examiner has rejected claim 4 as being obvious over U.S. Patent No. 6,296,377 Wilson et al (“Wilson”) in view of U.S. Patent No. 6,913,376 to Judd et al. (“Judd”) and further in view of U.S. Patent Application No U.S. 2005/0013196 to Russo (“Russo”).

The Applicants have submitted a Declaration showing that the date of their invention is prior to the effective date of Russo. Therefore, Russo cannot be used as basis for a rejection.

C. Claims 3 and 6

The Examiner has rejected claims 3 and 6 as being obvious over U.S. Patent No. 6,296,377 Wilson et al (“Wilson”) in view of U.S. Patent No. 4,306,280 to Burke (“Burke”).

The elements to describe a *prima facie* case of obviousness are described above.

The Examiner has failed to show a *prima facie* case of obviousness in this case because the Examiner has not shown:

- (i) the prior art discloses all of the claimed elements;
- (ii) a suggestion or motivation to modify or combine the reference teachings; and
- (iii) an expectation for success.

Claims 3 and 6 require, “providing a light fixture assembly having a light fixture body, a **post mount**, a chain mount, a coach mount, and a **finishing piece**.” (emphasis added).

The Examiner has indicated that Reference No. 162 in Wilson is a post mount or a tail. This is incorrect. A post mount is a weight bearing structure that allows the light fixture to be mounted to a post. See Declaration of Expert Fred W. Kimick dated December 5, 2005. Enclosed is a print out from lighting-fixtures-ceiling-fans.com showing a post mount. Reference No. 4 in Applicants' Figure 1 shows a post mount (please note that the reference line points to the top portion of the post mount and the structure below is part of the post mount). Wilson does not show a post mount.

Even if Wilson did show a post mount, there is no suggestion or motivation to combine Wilson with Burke.

"[A]n examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention." *In re Rouffett*, 149 F.3d 1350, 1357 (Fed. Cir. 1998).

The Examiner states, "it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the convertible modular lantern of Wilson with the chain taught by Burke, since the chain of Burke would provide the convertible modular lantern of Wilson ('377) with a light fixture, thus giving an ecstatic appearance hanging from the ceiling."

“A statement that modifications of the prior art to meet the claimed invention would have been 'well within the ordinary skill of the art' at the time the claimed invention was made' because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references”. MPEP 2143 (citing *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993)).

As can be seen from section 2143 of the MPEP, the Examiner is improperly making a judgment of obviousness solely on the basis that the references show all elements.

The only motivation to combine or modify the references is the Applicants' claims. The Examiner has used the Applicants' claimed invention as a blueprint and has combined references without any teaching or motivation to do so. It is well established law that it is improper to use the Applicants' claims as a blueprint and to reconstruct the invention from the prior art using the claim as a blueprint. *Grain Processing Corp. v. American Maize Products Corp.*, 840 F.2d 902 (Fed. Cir. 1988); *Smith Kline Diagnostics Inc. v. Helena Laboratories Corp.*, 859 F.2d 878 (Fed. Cir. 1988); *In re Stencel*, 828 F.2d 751 (Fed. Cir. 1987); *In re Dow Chemical*, 837 F.2d 469 (Fed. Cir. 1988); *Northern Telecom, Inc. v. Datapointe Corp.*, 908 F.2d 931 (Fed. Cir. 1990), *cert. denied*, 11 S.Ct. 296 (1990); *Interconnect Planning Corp., v. Feil*, 774 F.2d 1132 (Fed. Cir. 1985).

The Declaration of Expert Fred W. Kimick dated December 5, 2005 shows that there is no teaching or suggestion to modify the references.

“The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.” *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992); 1992 U.S. App. Lexis 18470; 23 U.S.P.Q. 2D (BNA) 1780 (emphasis added).

Additionally, Wilson’s rewiring feature and light cluster assembly do not appear to be likely to be successful with a chain mount of Burke. Even if it were successful, there is no disclosure or suggestion as to how to incorporate the features with Burke’s chain.

Claims 3 and 6 are not obvious over Wilson in view of Burke.

D. Claim 5

Claim 5 is rejected as being obvious over U.S. Patent No. 6,296,377 Wilson et al (“Wilson”) in view of U.S. Patent No. 4,306,280 to Burke (“Burke”) further in view of U.S. Patent Application No U.S. 2005/0013196 to Russo (“Russo”).

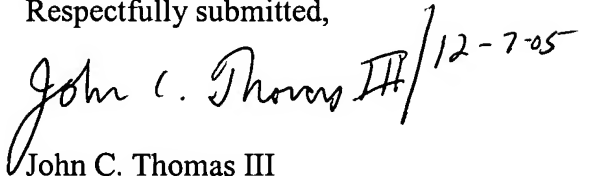
The Applicants have provided a Declaration executed on December 5, 2005 indicating a date of prior invention than the effective date of Russo. Therefore, Russo should not be used as a reference.



III. CONCLUSION

In view of the above, it is submitted that the claims now presented in the application are in condition for allowance. Accordingly, reconsideration and allowance of the claims are requested.

Respectfully submitted,

12-7-05

John C. Thomas III  
Reg. No. 52,282  
Paul A. Beck & Associates, P.C.  
Suite 100, 1575 McFarland Road  
Pittsburgh, PA 15216-1808  
Phone (412) 343-9700  
Fax (412) 343-5787  
Customer No. 09961